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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,953	07/16/2003	Lane Smith	P-103786.1.2 (UTI)(CONT)(8573
7590 Daniel D. Chapman Suite 2100 112 East Pecan St. San Antonio, TX 78205			EXAMINER CHAN, SING P	
			ART UNIT	PAPER NUMBER
			1734	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/22/2006	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 10/620,953	Applicant(s) SMITH ET AL.	
	Examiner Sing P. Chan	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bunyan (U.S. 5,115,104) in view of Dauber et al (U.S. 5,916,671) and Simon et al (U.S. 3,347,978).

Bunyan discloses a method of applying a gasket. The method includes providing a gasket comprising a conductive elastomer, which provided a non-sticky skin, a knitted wire mesh or a knitted wire mesh over an elastomeric core of elastomeric foam, such as foamed elastomeric thermoplastic, foamed natural or synthetic rubber, e.g. neoprene, foamed urethane or foamed silicone of open cell (Col 5, lines 47-65), attaching the gasket to the surface of the enclosure (Col 1, lines 36-39) such as an aircraft, computer housing, and computer rooms (Col 1, lines 31-35) with adhesive pressed against the substrate (Col 6, lines 7-16 and Figures 4 and 5), which show the adhesive is on only one side of the gasket, closing the panel or door to effectively sealing off the narrow gap (Col 1, lines 45-46). Bunyan is silent as to gasket material is partially saturated with polyurethane mix to the core, which provided a sticky side to the cord material. However, applying pressure sensitive adhesive to the cord of the gasket is well known and conventional as shown for example by Dauber et al. Dauber et al discloses a method of sealing a variety of structures. The method includes providing a gasket

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material, applying the pressure adhesive as transfer tape, double-sided tape or as a coating to the polymeric structure, i.e. gasket core with the coating, the adhesive is allow to partially saturated the gasket to increase the adhesive strength and increase the z-direction strength of the gasket (Col 8, lines 28-36), which allow for easy installation in enclosure that do not lay flat (Col 8, lines 23-25). Furthermore, Dauber et al recites out-gassing of silicone is a problem (Col 1, lines 42-45) and therefore, the examiner is taking the position the method would exclude using material with silicone to avoid out-gassing of silicone.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to partially saturate the gasket structure with adhesive as disclosed by Dauber et al in the method of Bunyan to allow for easy installation of the gasket to enclosure that do not lay flat and insure that if an enclosure is reopened the gasket will preferentially remain to the side of the enclosure where the pressure sensitive adhesive is applied. (See Dauber et al, Col 8, lines 23-27) Bunyan as modified by Dauber et al is silent as to the adhesive is a polyurethane mix. However, providing a polyurethane mix as the adhesive for saturating the gasket material is well known and conventional as shown for example by Simon et al. Simon et al discloses a method forming conductive joint and gasket. The method includes providing an adhesive material to surrounds all of the fibers and in contact with and bonded to the surface with the adhesive (Col 2, lines 35-45) includes resin such as phenolic resins such as rubber, vinyl or epoxy, nitrile rubber, neoprene, vinyl, vinyl acetate-vinyl chloride copolymers, polyvinyl butyral, polyolefins (polyethylene and polypropylene), polysulfide, carboxylic, resorcinol, amino

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isocyanate-base (polyurethane), cyano-acrylate, polyamide, and polyester. (Col 2, line 57 to Col 3, line 7)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any adhesive such as polyurethane to joint and bond the gasket material to the surface as disclosed by Simon et al in the method of Bunyan as modified by Dauber et al to provide a simple and inexpensive to bond a gasket to an aircraft and provide an electrical connection to the jointing parts. (See Simon et al, Col 1, lines 22-55)

Response to Arguments

In response to applicant's argument of Bunyan and Dauber do not recite a gasket material as having an open cell foam base partially saturated with a silicone-free, polyurethane mix, the examiner disagrees since Bunyan does recite the gasket material is formed of open cell elastomeric foam material for an aircraft and Dauber does recite the gasket material is partially saturated with adhesive, and the newly cited reference to Simon et al discloses the adhesive for jointing substrate with a gasket includes polyurethane for an aircraft. The combination of Bunyan, Dauber, and Simon et al discloses the instant invention.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sing P. Chan whose telephone number is 571-272-1225. The examiner can normally be reached on Monday-Thursday 7:30AM-11:00AM and 12:00PM-4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher A. Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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